

## REMARKS

It is requested that this amendment be entered since it places the application in condition for allowance and/or reduces the issues on appeal. Herein, the subject matter of certain dependent claims has been incorporated in the parent independent claims and the remaining dependent claims have been cancelled.

The present invention relates to the provision of a sanitary article containing fibers bearing metallic silver. The metallic silver is applied to the fiber surfaces only and in a manner that provides a more constant silver ion concentration at the article surface facing the body during use.

In order to better distinguish over the art, all of the claims have been amended to recite that the fiber outer surfaces include depressions, and that the metallic silver is attached to the outer surfaces including the surfaces in the depression. To that end, claim 30 has been amended to include the subject matter of dependent claim 31, which is cancelled and claim 49 has been amended to include the subject matter of dependent claim 52, which is also cancelled. Only amended independent claims 30 and 49 are pending herein.

The amended claims recite the presence of depressions in the fiber outer surface. The depressions provide the fiber surface with increased area for attachment of metallic silver.

Further, the depressions enhance the gripping or attachment of the metallic silver to the fiber surface.

The preference for fiber surfaces having depressions in accordance with the invention is described at pages 3 and 6 of the specification. Metallic silver attachment to the fiber outer surface including the surface within the depressions may be achieved through electro-, chemical or electrochemical deposition, as well as by vapor deposition. Also, the fiber surface may be mordanted, as described at page 6, to further enhance the attachment of the metallic silver to the fiber surface including the surface within the depressions.

It is requested that the Examiner reconsider and withdraw the rejection of the claims under 35 USC 102(b) as anticipated by Hanke, EP 1066825. Hanke does not teach the presence of depressions in fiber outer surfaces, nor that the metallic silver is attached or bound to the fiber outer surface in the depressions. The claimed depressions are not addressed in the final rejection or in any other action. Accordingly, the rejection of the claims under 35 USC 102(b) as unpatentable over Hanke is in error and should be withdrawn.

The rejection of claims 36, 48 and 56 under 35 USC 103(a) is moot since these claims are cancelled.

The Response to Arguments presented in the Office action does not address the foregoing structural differences in article claim 30 and method differences in process claim 49.

In the first paragraph of the response, the deficiencies in Hanke to recognize the problem solved by the present invention and/or to suggest the stability of the claimed article are deemed to be implied by the patentee's representation that his product is "ideally suited for applications, wherein during normal use, said product is in contact with the human or animal skin and/or mucosa for a longer period of time by preventing irritation of the skin of the user or any negative changes to the skin structure." Based on this representation, the Examiner states:

"Therefore, it is reasonable to conclude the product will be present for prolonged periods and not flushed away in use."

First, there is no necessary relationship between prolonged exposure without negative skin effects and prevention of migration. Second, there is no reason to believe that the product is not flushed away. It is just as plausible to conclude that the product (active ingredient, metallic silver) was flushed away since no negative skin affects (e.g. cytotoxicity) result. Third, the Examiner is well aware that

the standard for inherency is not whether something is reasonable, but that it necessarily results. As noted in Section 2112 (IV) of the MPEP:

"In relying upon the theory of inherency, the Examiner must provide a basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristic necessarily flows from the teachings of the applied prior art." *Ex parte Levy*, 17 USPQ2d 1461, 1464 (Bd. Pat. App. & Inter. 1990).

In the present case, there is no basis in fact or technical reasoning to support the determination posed in the response. Moreover, it is quite clear that the alleged property does not necessarily flow from the teachings of the applied prior art.

In the second paragraph of the Response to Arguments, the teachings of the Hanke reference in paragraph 0023 are misconstrued. Further, the Hanke teaching of the metallic silver in a homogeneous fluid matrix precludes the metallic silver from "exclusively" attaching or binding to the fiber outer surface as required by all of the claims of record.

For all of the foregoing reasons, it is respectfully submitted that all of the claims presently of record are in condition for final allowance and such action is requested.

If there are any further fees required by this amendment,  
please charge the same to Deposit Account No. 16-0820, Order No.  
36403.

Respectfully submitted,

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